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In the Supreme Court of the United States

J.E.M. AG SUPPLY, INC., DBA FARM ADVANTAGE, INC., ET AL., PETITIONERS

v.

PIONEER HI-BRED INTERNATIONAL, INC.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

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QUESTION PRESENTED

Whether sexually reproduced plants are patentable subject matter under 35 U.S.C. 101.

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This brief is submitted in response to the Court's order inviting the Solicitor General to express the views of the United States.

STATEMENT

1. Three different statutory schemes are relevant to this case. First, 35 U.S.C. 101 provides in pertinent part that "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of [Title 35]." In *Ex parte Hibberd*, 227 U.S.P.Q. (BNA) 443 (Bd. Pat. App. & Interf. 1985),

the Board of Appeals and Interferences of the Patent and Trademark Office (PTO) held that sexually reproduced plants (*i.e.*, plants reproduced from seeds) are eligible for patent protection under Section 101. *Id.* at 443-447. During the 15 years since that decision, the PTO has issued hundreds of so-called "utility patents" protecting sexually reproduced plants.

Under the Plant Patent Act of 1930 (PPA), ch. 312, 46 Stat. 376 (35 U.S.C. 161-164 (1994 & Supp. IV 1998)), the PTO may grant plant patents covering new and distinct varieties of asexually reproduced plants. Asexually reproduced plants are plants that are reproduced from a single parent, such as by grafting, budding, cutting, rooting, or layering. Section 161 of Title 35 provides:

> Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 161. Section 161 further provides that, except as otherwise provided, "[t]he provisions of [Title 35] relating to patents for inventions shall apply to patents for plants." 35 U.S.C. 161. The PTO has granted more than 10,000 plant patents under Section 161.

Finally, the Plant Variety Protection Act (PVPA), Pub. L. No. 91-577, § 42, 84 Stat. 1547, provides statutory protection to novel varieties of sexually reproduced plants that meet statutory criteria of distinctness, uniformity, and stability. 7 U.S.C. 2402(a) (1994 & Supp. IV 1998). In providing protection for sexually reproduced plants under the PVPA, Congress

established a regime, separate from the patent laws, under which the Department of Agriculture issues plant variety certificates to breeders of novel varieties of sexually reproduced plants. See 7 U.S.C. 2483 (1994 & Supp. IV 1998) ("Contents and term of plant variety protection").

2. Respondent is the world's largest producer of seed corn, and holds utility patents granted, under Section 101 of Title 35, for sexually produced corn hybrids. Respondent filed suit against petitioners, alleging that they infringed respondent's patents covering 17 corn seed products by making, using, and selling or offering for sale seed corn of these patented hybrids. Petitioners are not authorized sales representatives of respondent. Pet. App. 14-15.

Petitioners asserted, among other defenses, the defense of patent invalidity. Petitioners also asserted a counterclaim seeking a declaratory judgment that all of the patents relied upon in respondent's complaint are invalid. Petitioners moved for summary judgment on their counterclaim, arguing that patents directed to sexually reproduced plants are not authorized under Section 101, and that Congress intended the PPA and PVPA to be the exclusive means of securing protection for plants. Pet. App. 15-16.

The district court denied petitioners' motion for summary judgment and held that Section 101 authorizes the issuance of patents covering sexually reproduced plants. Pet. App. 13-39. Relying upon this Court's decision in *Diamond* v. *Chakrabarty*, 447 U.S. 303 (1980), the district court concluded that the text of Section 101 authorizes the grant of patents covering plants, Pet. App. 22, and that Congress's intention in adopting the PPA and PVPA was not to limit Section 101, but rather "to extend patent protection to an area [histori-

cally] not often able to meet the requirements" for protection under Section 101, *id.* at 29.

3. On interlocutory appeal under 28 U.S.C. 1292(b), the court of appeals affirmed. Starting from the premise that "Congress plainly contemplated that [Section 101] would be given wide scope," Pet. App. 4 (quoting *Chakrabarty*, 447 U.S. at 308), the court of appeals found that nothing in the text of Section 101, the PPA, or the PVPA narrows that scope by excluding plants from eligibility for protection, *id.* at 6-8. Nor did the court of appeals find any conflict between patent protection for sexually reproduced plants under Section 101 and certification of such plants under the PVPA. The court determined "that the asserted conflict [between the statutes] is simply the difference in the rights and obligations imposed," not any difficulty in applying the two statutes simultaneously. *Id.* at 8-9.[1]

DISCUSSION

The decision of the court of appeals is correct, and is not in conflict with any decision of this Court or any other court of appeals. Further review by this Court is not warranted.

1. This Court held in *Chakrabarty*, *supra*, that Congress's grant of patent authority in Section 101 should be broadly construed. Section 101 provides that "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter * * * may obtain a patent therefor." 35 U.S.C. 101. The Court has defined "manufacture" "to mean 'the production of articles for use from raw or prepared

[1] The court of appeals declined to address other claims regarding the validity of respondent's particular plant patents, which the district court had not considered and petitioners do not advance before this Court. Pet. App. 9.

materials by giving to these materials new forms, qualities, properties, or combinations.'" *Chakrabarty*, 447 U.S. at 308 (quoting *American Fruit Growers, Inc.* v. *Brogdex Co.*, 283 U.S. 1, 11 (1931)). The phrase "composition of matter" reaches "all compositions of two or more substances and . . . all composite articles, whether they be the results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." *Ibid.* (internal quotation marks omitted). "In choosing such expansive terms, * * * modified by the comprehensive 'any,' Congress plainly contemplated that the patent laws would be given wide scope." *Ibid.*

The *Chakrabarty* Court also reviewed the legislative history of Section 101, 447 U.S. at 308-309, and concluded that it confirms Congress's understanding that the patentable subject matter reached by Section 101 "include[s] anything under the sun that is made by man," *id.* at 309 (quoting S. Rep. No. 1979, 82d Cong., 2d Sess. 5 (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess. 6 (1952)), provided the other requirements for patentability are satisfied.

In light of the text of Section 101 and its history, the Court held in *Chakrabarty* that a nonnatural, genetically engineered bacterium capable of breaking down multiple components of crude oil "plainly" was within the subject matter of patent under Section 101, being either a "manufacture" or "a composition of matter." 447 U.S. at 305, 309-310. The same reasoning applies to plants, such as the patented corn hybrids at issue in this case. Where a plant has "markedly different characteristics from any found in nature" (which is not in dispute for purposes of this petition) and "ha[s] the potential for significant utility" (also not at issue here), the plant "is patentable subject matter under § 101."

Id. at 310; see also *id.* at 311 (rejecting argument that the terms "manufacture" and "composition of matter" do not include living things). Accordingly, novel plants made by human intervention, as well as seeds and tissue cultures from those plants, are eligible for patent protection, subject to the conditions and requirements of Title 35.

2. Petitioners base their attempt to overcome *Chakrabarty* upon Congress's extension of specific protection to plants through the PPA and PVPA. See Pet. 7-30. Petitioners argue that Congress has chosen to limit patent and patent-like protection for plants, unlike bacteria and other living things, to the specific protections provided under the PPA and PVPA. Once again, however, the contrary holding of this Court in *Chakrabarty* is controlling.

As petitioner in *Chakrabarty*, the United States similarly argued that the adoption of specific protections for plants in the PPA and PVPA, and the surrounding legislative history, demonstrated Congress's understanding that Title 35 would not otherwise afford patent protection to plants, and that the PPA and PVPA would be the exclusive means of securing patent or patent-like protection for plants. Brief for Pet. at 21-37 (No. 79-136). This Court rejected the government's submission, and we see no reason to revisit the issue in this case.

In reaching the conclusion that the PPA and PVPA do not impliedly establish an exclusion from the scope of patentable subject matter under Section 101, this Court reviewed the history of both statutes. The Court explained that, when Congress enacted the PPA in 1930, it sought to address two restrictions in the patent laws that were then thought to preclude protection for asexually reproduced plants as a practical matter. The

first restriction was the belief, in some quarters, that plants were products of nature rather than of man for purposes of patent law, and remained so even if artificially bred. *Chakrabarty*, 447 U.S. at 311-312. The second restriction was the requirement that the subject of the patent be described in writing in sufficient detail to allow reproduction of the invention, a requirement that it was thought impossible to satisfy in the case of plants. *Id.* at 312; see 35 U.S.C. 33 (1925) ("inventor * * * shall file * * * a written description of the [invention]"); 35 U.S.C. 112 (current codification of "written description" requirement). Congress resolved both issues in favor of patentability through the PPA, thereby ensuring that patent protection would be afforded to innovations in plant breeding notwithstanding the difficulties in obtaining protection under Section 101. Accordingly, the Court held in *Chakrabarty* that the legislative history of the PPA does not reveal a congressional understanding that plants necessarily are, or thereafter would be, outside the broad scope of patentable subject matter under Section 101. 447 U.S. at 312-313; see generally *Barr* v. *United States*, 324 U.S. 83, 90 (1945) ("[I]f Congress has made a choice of language which fairly brings a given situation within a statute, it is unimportant that the particular application may not have been contemplated by the legislators.").

The Court similarly held in *Chakrabarty* that the PVPA was enacted to reflect advances in breeding techniques that made it possible to reproduce new varieties of plants, true-to-type, through seeds.[2] Again, the Court concluded that nothing in the language or legislative history of the PVPA reflects a congressional

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[2] In true-to-type reproduction, the plant inherits genetic characteristics identical to those of the parent plant.

view that plants were or would be categorically ineligible for protection under Section 101, in the event that eligibility could be established in accordance with the terms of Section 101 and Title 35. *Chakrabarty*, 447 U.S. at 313.

The dissenting Justices in *Chakrabarty*, like the government in that case and petitioners here, argued that, when it adopted the PPA and PVPA, "Congress thought it had to legislate in order to make agricultural 'human-made inventions' patentable." 447 U.S. at 321. Accordingly, the dissenters concluded that such agricultural inventions are protectable only insofar as they come within the scope of the PPA or PVPA. *Id.* at 318-322 (Brennan, J., dissenting). The dissenters' view, of course, was rejected. Petitioner does not suggest any justification for reopening that decision. This Court, moreover, has consistently recognized that the doctrine of stare decisis has special force in matters of statutory interpretation, which Congress remains free to address through amending legislation. See, *e.g.*, *Hilton* v. *South Carolina Pub. Rys. Comm'n*, 502 U.S. 197, 205 (1991) ("*stare decisis* is most compelling" where "a pure question of statutory construction" is involved).

3. Petitioner argues (Pet. 24-27) that interpreting Section 101 as allowing utility patent protection for sexually reproduced plants that otherwise meet the requirements of Title 35 would create "[i]rreconcilable [c]onflicts" (Pet. 24) with the PVPA, so that Congress should be presumed to have intended that protection under Section 101 would not be available. As both the district court and the court of appeals determined, however, the asserted "conflicts" between Section 101 and the PVPA are merely "difference[s]" in the requirements for obtaining protection, the administrative schemes, and the scope of the protection afforded. Pet.

App. 9, 30-34. While some overlap is possible, petitioners do not establish (Pet. 24-27) that implementation of one scheme precludes implementation of the other.

Nor does implementation of the provisions of Section 101 in the context of sexually reproduced plants nullify the PVPA. Section 101 and the PVPA instead provide distinct and complementary protection. See generally *Watt* v. *Alaska*, 451 U.S. 259, 267 (1981) ("We must read the statutes to give effect to each if we can do so while preserving their sense and purpose."); *United States* v. *Borden Co.*, 308 U.S. 188, 198-199 (1939) ("When there are two acts upon the same subject, the rule is to give effect to both if possible. * * * It is not sufficient * * * to establish that subsequent laws cover some or even all of the cases provided for by [the prior act] * * *. There must be a positive repugnancy between the provisions of the new law, and those of the old.") (citations and internal quotation marks omitted).[3]

For instance, an invention or discovery must be new, useful, and not obvious to receive utility patent protection under Section 101. 35 U.S.C. 101-103 (1994 & Supp. IV 1998). Plant variety protection certificates, however, may be issued with respect to sexually reproduced plant varieties that are new, distinct, uniform, and stable. 7 U.S.C. 2402 (1994 & Supp. IV 1998). Thus, as the name indicates, utility patents under Section 101 require usefulness, whereas the PVPA does not. The characteristics of the plant variety protected under the PVPA also may not meet the requirement of non-obviousness that applies to a utility patent.

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[3] Petitioners' reliance (Pet. 12-14) upon the Court's prioritization of conflicting statutes in *FDA* v. *Brown & Williamson Tobacco Corp.*, 120 S. Ct. 1291, 1301 (2000), is thus misplaced.

To obtain utility patent protection, moreover, the applicant must provide a written description of how to make and use the disclosed invention. 35 U.S.C. 112. That disclosure requirement benefits the public by ensuring that others will be able to make, use, and build upon patented discoveries once the patent expires. (As discussed above, the difficulty plant breeders had in complying with the disclosure requirement led Congress to adopt the PPA's less-rigorous requirement that the applicant's written description must be "as complete as is reasonably possible." 35 U.S.C. 162.) By contrast with the requirements for issuance of a patent under both Section 101 and the PPA, the PVPA requires only a description of the plant, along with a deposit of seed in a public depository. 7 U.S.C. 2422.[4]

Although more difficult to obtain, utility patent protection for sexually reproduced plants and seeds under Section 101 is broader in scope than the protection afforded by a plant variety protection certificate under the PVPA. The protection afforded by a certificate is limited to the particular variety described therein. See 7 U.S.C. 2402(a) (1994 & Supp. IV 1998). A utility patent, by contrast, may be granted to protect discoveries embracing a class or species of plants, and does not have to be limited to a particular plant variety.[5]

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[4] The seed deposit requirement ensures that the statutory criteria of uniformity and stability are satisfied, but, unlike the description requirements of Title 35, does not suffice to place the invention in the public domain after the term of protection expires.

[5] For example, the PTO has issued a utility patent covering rice plants with increased resistance to herbicides. See U.S. Patent No. 5,545,822A (Aug. 13, 1996). The broader coverage available through Section 101 is increasingly important in light of advances in genetic engineering, such as use of recombinant DNA technology to develop utility-patented plants having improved insecticidal properties. See U.S. Patent No. 5,977,442A (Nov. 2, 1999). The breadth of coverage afforded by utility patents may be essential in some circumstances to protect plant inventions produced by genetic engineering.

The PVPA also establishes several exemptions to infringement that do not apply to utility patents. The exclusive rights granted by a certificate of plant variety protection are subject to a prior use clause (7 U.S.C. 2542), a research exemption (7 U.S.C. 2544), and a crop exemption for farmers (7 U.S.C. 2543), all of which may limit the breeder's ability to recover an economic return.

For those applicants who can comply with the stringent requirements for patentability under Section 101, utility patent protection offers more extensive protection than the PVPA. Limiting the scope of Section 101 to exclude sexually reproduced plants—thus denying that broader protection—would be contrary to congressional intent (as interpreted in *Chakrabarty*, *supra*) and would reduce incentives for research and development in the agricultural and horticultural arts.

4. Finally, citing *Ropat Corp.* v. *McGraw-Edison Co.*, 535 F.2d 378 (7th Cir. 1976), petitioners suggest that the court of appeals wrongly approved "[d]ual protection of the same invention." Pet. 26-27. *Ropat* held that dual patents (a design patent and a utility patent) could not be issued on the same aspect of the same invention. 535 F.2d at 381. The court of appeals in that case simply applied the settled rule that, in order to avoid prolonging the period of a patent monopoly beyond that intended by Congress, "two valid patents for the same invention cannot be granted either to the same or to a different party." *Miller* v. *Eagle Mfg. Co.*, 151 U.S. 186, 197 (1894).

Here, the only relevant patents held by respondent are utility patents issued under Section 101, and petitioners' challenge to their validity is based on the argument that respondent should have secured protection under the PVPA instead. See Pet. 3-5. The record thus indicates that respondent holds only one patent for each invention, and the rule against "double patenting" is not implicated.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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